Remarks

This Application has been carefully reviewed in light of the Office Action mailed January 2, 2009. Applicant has amended Claim 1 to correct a typographical error. This amendment is not considered narrowing or necessary for patentability, and is not made in relation to any reference cited by the Examiner. Applicant believes all claims are allowable over the cited references without amendment and respectfully provides the following remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. The Office Action is Deficient

In the Final Office Action mailed April 15, 2008 (the "Final Office Action"), the Examiner rejected Claims 1-3, 6, 13-15, 18, 25, and 27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,269,431 to Dunham ("*Dunham*"). In a Response Accompanying Request for Continued Examination (RCE) mailed September 30, 2008 (the "RCE"), Applicant added various limitations to independent Claims 1, 13, and 25. *See RCE* at 2-6. In the current non-final Office Action (the "Office Action"), the Examiner acknowledges that the amendments to Claims 1, 13, and 25 have been entered. *See Office Action* at 2. The Examiner then rejects independent Claims 1-5, 13-17, and 25-26 under 35 U.S.C. § 102(e) as being anticipated by *Dunham*. *Office Action* at 5.

In rejecting independent Claims 1, 13, and 25, the Examiner does not cite any portion of *Dunham* as disclosing various limitations of Claims 1, 13, and 25, particularly those limitations added by Applicant in the RCE. *See Office Action* at 5-11. Applicant respectfully reminds the Examiner that under 35 U.S.C. § 132, "[w]henever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection, . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." Because the Examiner's rejection of independent Claims 1, 13, and 25 based on *Dunham* does not address various limitations of independent Claims 1, 13, and 25, Applicant submits that the Examiner's rejection does not state the "reasons for such rejection . . . together with such information and references as may be useful in judging the propriety of continuing the

prosecution of [the] application," as required by 35 U.S.C. § 132. Additionally, 37 C.F.R. §1.104 states the following:

> In rejecting claims for want of novelty or obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not apparent, must be *clearly explained* and each rejected claim specified.

37 C.F.R. § 1.104(c)(2) (emphasis added). Applicant submits that the *Dunham* reference is complex; thus, 37 C.F.R. § 1.104 requires the Examiner to designate the particular portions of *Dunham* relied as allegedly anticipating the limitations in each of Applicant's claims.

Additionally, despite having identified *Dunham* as the basis for rejecting dependent Claims 2-5, 14-17, and 26, the Examiner appears to cite portions of U.S. Patent 6,728,848 to Tamura ("*Tamura*") in rejecting these dependent claims. *See Office Action* at 11-13. Applicant respectfully reminds the Examiner that "[w]here a claim is refused for any reason relating to the merits thereof it should be 'rejected' and *the ground of rejection fully and clearly stated . . . .*" M.P.E.P. ch. 707.07(d). Because the Examiner identified *Dunham* as the basis for rejecting dependent Claims 2-5, 14-17, and 26 but appears to rely at least in part on *Tamura*, the Examiner has not clearly stated the ground of rejection as required by M.P.E.P ch. 707(d).

Additionally, the Examiner rejects dependant Claims 6-7, 18-19, and 27-28 under 35 U.S.C. §103(a) as being unpatentable over *Tamura* in view of U.S. Patent 6,446,175 to West ("*West*"). The Examiner rejects dependant Claims 8-9, 21-22, and 29-30 under 35 U.S.C. §103(a) as being unpatentable over the proposed *Tamura-West* combination in view of U.S. Patent 6,785,786 to Gold ("*Gold*"). The Examiner rejects dependant Claims 10-12, 22-24, and 31-33 under 35 U.S.C. §103(a) as being unpatentable over the proposed *Tamura-West* combination in view of U.S. Patent 6,738,923 to Blam ("*Blam*"). Dependent Claims 6-12, 18-24, and 27-33 depend from independent Claims 1, 13, and 25, respectively. As discussed above, the Examiner rejects independent Claims 1, 13, and 25 under 35 U.S.C. §102(e) as being anticipated by *Dunham*. However, the Examiner does not cite *Dunham* as a basis for rejecting dependent Claims 6-12, 18-24, and 27-33 under 35 U.S.C. §103(a). Thus, it is

unclear to Applicant which reference the Examiner is asserting discloses each of the limitations of the independent claims from which the above-discussed dependent claims depend. Because of this lack of clarity, Applicant submits that the Examiner's rejection of dependent Claims 6-12, 18-24, and 27-33 neither states the "reasons for such rejection . . . together with such information and references as may be useful in judging the propriety of continuing the prosecution of [the] application" (as required by 35 U.S.C. § 132, discussed above) nor the clearly states the ground of rejection (as required by M.P.E.P ch. 707(d), discussed above).

Applicant requests that that the Examiner clarify the basis for the above-discussed rejections as required by at least 35 U.S.C. § 132, 37 C.F.R. § 1.104(c)(2), and M.P.E.P. ch. 707(d). Applicant submits that it would be improper to make the next Office Action final in light of the deficiencies of this *Office Action*. Although the Examiner is undoubtedly responsible for the examination of a large number of applications, placing inordinate constraints on the Examiner's time, Applicant cannot be penalized for this fact and are still entitled to a full and complete examination of this Application in compliance with all applicable statutes, regulations, rules, and case law.

II.   Claims 1-5, 13-17, 25-26 are Allowable over *Dunham*

The Examiner rejects Claims 1-5, 13-17, and 25-26 under 35 U.S.C. § 102(e) as being anticipated by *Dunham*. Applicant respectfully traverses these rejections and discusses independent Claim 1 as an example.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. ch. 2131. "The *identical invention* must be shown in as *complete detail as contained* in the . . . claim ." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); *see also* M.P.E.P. ch. 2131. In addition, "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed.

Cir. 1990); M.P.E.P. ch. 2131.

The Federal Circuit recently clarified this standard in *Net Moneyin, Inc. v. Verisign, Inc.*, 2008 WL 4614511 (Fed. Cir. 2008). In *Net Moneyin*, the Federal Circuit held that a finding of anticipation under 35 U.S.C. § 102 is proper only when a "reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way* as recited in the claim." *Net Moneyin* at *10 (emphasis added). The prior art reference must "*clearly and unequivocally* disclose the claimed invention ... *without any need for picking, choosing, and combining various disclosures not directly related to each other by* the teachings of the cited reference." *Id.* (emphasis added, internal typographical notations omitted).

At a minimum, the cited portions of *Dunham* fail to disclose, teach, or suggest the following limitations recited in Claim 1:

- the backup storage system operable to:
    - *obtain a static view of a relevant portion of the storage system*;
    - *map one or more blocks of data comprising the information being backed up to corresponding files*; and
    - *back up the information by transferring the information being backed up using one or more data movers operable to transfer the information* being backed up directly from the storage system to the backup storage system, *using one or more extended copy commands*, without going through the one or more servers; and
    - *restore the information by transferring the information being restored using one or more data movers operable to transfer the information* being restored directly from the backup storage system to the storage system, *using one or more extended copy commands*, without going through the one or more servers.

For example, *Dunham* fails to disclose, teach, or suggest "information being backed up using one or more data movers operable to transfer the information being backed up directly from the storage system to the backup storage system, *using one or more extended copy commands*, without going through the one or more servers" and "information being restored using one or more data movers operable to transfer the information being restored

directly from the backup storage system to the storage system, *using one or more extended copy commands*, without going through the one or more servers," as recited in Claim 1. As allegedly disclosing these limitations (prior to the amendments presented in the RCE), the Examiner cites column 1, line 60 through column 2 line 18; column 3, line 48 through column 4, line 23; and column 5, lines 26-44 of *Dunham*. *Office Action* at 6-7.

The cited portions of *Dunham* disclose that "[t]he data storage subsystem has primary data storage, and the backup versions are stored in secondary data storage linked to the data storage subsystem for transfer of the backup versions from the secondary data storage to the data storage subsystem." *Dunham* at 1:63-67. Additionally, "[t]he data storage subsystem includes . . . a storage controller coupled to the primary data storage for controlling access to the primary data storage. The storage controller has at least one data port for linking the primary data storage and the secondary data storage to the host processor for transfer of data between the primary data storage and the secondary data storage and the host processor." *Id.* at 51-57. "[S]pecified data in the primary storage 27 is copied to the secondary storage 29 when the primary data storage subsystem 21 receives a backup command from the host 20." *Id.* at 5:29-32.

Based on the portions of *Dunham* cited by the Examiner, it appears that the Examiners is equating the "primary storage" disclosed in *Dunham* with the "storage system" recited in Claim 1 and the "secondary storage" disclosed in *Dunham* with the "backup storage system" recited in Claim 1. Furthermore, the Examiner appears to be asserting that the cited portions of *Dunham* disclose transferring data (e.g., using data movers 72-75) from the primary storage to the secondary storage via a data port linking the primary and secondary data storage such that *Dunham* discloses "information being backed up using one or more data movers operable to transfer the information being backed up directly from the storage system to the backup storage system" and "information being restored using one or more data movers operable to transfer the information being restored directly from the backup storage system to the storage system," as recited in Claim 1.

Even assuming for the sake of argument only that these apparent equations and

assertions are proper (which Applicant does not concede), it appears that *Dunham* would still fail to disclose, teach, or suggest the above-recited limitations of Claim 1. For example, the cited portions of *Dunham* do not appear to disclose transferring data from the primary storage to the secondary storage via a data port linking the primary and secondary data storage *"using one or more extended copy commands,"* as recited in Claim 1. Thus, for at least this reason, *Dunham* fails to disclose, teach, or suggest "information being backed up using one or more data movers operable to transfer the information being backed up directly from the storage system to the backup storage system, *using one or more extended copy commands*, without going through the one or more servers" and "information being restored using one or more data movers operable to transfer the information being restored directly from the backup storage system to the storage system, *using one or more extended copy commands*, without going through the one or more servers," as recited in Claim 1.

As another example, the cited portions of *Dunham* fail to disclose, teach, or suggest a backup storage system operable to *"obtain a static view of a relevant portion of the storage system"* and *"map one or more blocks of data comprising the information being backed up to corresponding files,"* as recited in Claim 1. As discussed above, the Examiner has not cited any portion of *Dunham* as allegedly disclosing these limitations of Claim 1. Furthermore, Applicant submits that the above-discussed cited portions of *Dunham* fail to disclose, teach, or suggest these limitations of Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully request reconsideration and allowance of independent Claims 13 and 25 and their dependent claims.

II.   Claim 34 is Allowable over *Spilo*

The Examiner rejects Claim 34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,208,999 to Spilo (*"Spilo"*). Applicant respectfully traverses this rejection. Applicant reiterates the above-discussed heavy burden incumbent on the Examiner to support a finding of anticipation.

At a minimum, the cited portions of *Spilo* fail to disclose, teach, or suggest the following limitations recited in Claim 34:

- examining the attributes of each file and determining whether a file is resident or non resident;
- backing up entire attributes of a file if it is determined that the file is resident; and
- backing up attributes and data blocks belonging to the file if it is determined that the file is non resident.

A. The Examiner's arguments presented in the *Final Office Action* and reiterated in the current *Office Action* are flawed

1. The cited portion of *Spilo* do not disclose, teach, or suggest "examining the attributes of each file and determining whether a file is resident or non resident," as recited in Claim 34.

As allegedly disclosing "examining the attributes of each file and determining whether a file is resident or non resident," the Examiner cites column 4, line 66 through column 5, line 11 of *Spilo*, stating that "the disk can be scanned to find missing files." *Office Action* at 3. The cited portion of *Spilo* discloses that "[f]ile allocation information can be dynamically maintained and can be reconstructed in cases of loss or damage by scanning the disk for blocks having identification and sequence numbers, and rebuilding the files accordingly . . . . If the directory structure is damaged, the disk can be scanned to find missing files." *Spilo* at 4:66-5:11. *Spilo* further discloses that each block of a data file contains a signature area including "a file identification number, uniquely identifying the block as belonging to a particular data file, and a sequence number, which indicates the order in which the file's blocks belong within the file." *Id.* at 4:47-53.

In other words, the cited portion of *Spilo* appears to disclose that, if a directory structure is damaged, a data file within that directory structure may be recovered by scanning for data blocks having a common identification number (indicating that the blocks belong to the same data file) and ordering the data blocks according to a sequence number (indicating the sequence of the data blocs within the data file). Applicant submits that scanning data blocks and assembling them into data files as part of a recovery process (as apparently disclosed in *Spilo*) does not disclose, teach, or suggest "determining whether a file is resident or non resident," as recited in Claim 34.

The Examiner also cites column 10, lines 12-16 of *Spilo*, stating that "a flag in the directory entry and in each data block is set to indicate that the file is no longer present." *Office Action* at 3. The cited portion of *Spilo* states that "[i]n an alternative form of file deletion, the file identification numbers [of the data blocks of the file] are not obliterated, nor are the blocks erased, but a flag in the directory entry and in each data block is set to indicate that the file is no longer present." *Spilo* at 10:12-16. Applicant submits that flagging data blocks corresponding to a deleted data file rather than erasing the data blocks (as apparently disclosed in *Spilo*) does not disclose, teach, or suggest "determining whether a file is resident or non resident," as recited in Claim 34.

Therefore, the above-discussed portions of *Spilo* do not disclose, teach, or suggest "examining the attributes of each file and determining whether a file is resident or non resident," as recited in Claim 34.

2. The cited portions of *Spilo* do not disclose, teach, or suggest "backing up entire attributes of a file if *it is determined that the file is resident*" and "backing up attributes and data blocks belonging to the file if *it is determined that the file is non resident,*" as recited in Claim 34.

First, as discussed above, scanning data blocks and assembling them into data files as part of a recovery process (as apparently disclosed at column 4, line 66 through column 5, line 11 of *Spilo*) does not disclose, teach, or suggest "determining whether a file is resident or non resident," as recited in Claim 34. Because the cited portion of *Spilo* does not disclose the "determination" recited in Claim 34, the additional portion of *Spilo* cited by the Examiner (column 10, lines 57-65) necessarily fails to disclose, teach, or suggest taking any action in response to the determination, let alone "backing up entire attributes of a file *if it is determined that the file is resident*" and "backing up attributes and data blocks belonging to the file *if it is determined that the file is non resident,*" as recited in Claim 34.

Second, as allegedly disclosing "backing up entire attributes" and "backing up attributes and data blocks," the Examiner cites column 10, lines 57-65 of *Spilo*. *Office Action* at 4. The cited portion of *Spilo* discloses that "a supervisory program monitors disk operations, tracking those files that have been created or changed on the FAT file system.

Then, periodically, or during idle time, the supervisory program takes appropriate action to copy, modify, or erase the data on the device embodying the file system." *Spilo* at 10:59-64 The Examiner then cites column 4, line 66 through column 5, line 11 (discussed above) as allegedly disclosing the determination as to whether the file is resident (such that entire attribute of a file are backed up) or non-resident (such that attributes and data blocks of a file are backed up), as recited in Claim 34..

Even assuming that the above-discussed cited portions of *Spilo* did disclose "determining whether a file is resident or non resident" (which Applicant does not concede), the cited portion of *Spilo* would still fail to disclose, teach, or suggest "backing up entire attributes of a file if it is determined that the file is resident" and "backing up attributes and data blocks belonging to the file if it is determined that the file is non resident," as recited in Claim 34. It is unclear how the scanning data blocks and assembling them into data files as part of a recovery process (*Spilo* at portion 4:66-5:11, cited by the Examiner as allegedly disclosing "determining whether a file is resident or non resident") impacts the "supervisory program [taking] appropriate action to copy, modify, or erase the data on the device embodying the file system" (*Spilo* at 10:47-49, cited by the Examiner as allegedly disclosing "backing up entire attributes" and "backing up attributes and data blocks"). In other words, *how does scanning data blocks and assembling them into data files as part of a recovery process affect the "appropriate action" taken by the supervisory program?* Applicant's claim recites that a determination is made "whether a file is resident or non resident" and, based on that determination, either entire attributes of a file are backed up *"if it is determined that the file is resident"* or "attributes and data blocks" of a file are backed up *"if it is determined that the file is non resident."* It does not appear that the cited portion of *Spilo* discloses, teaches, or suggests these limitations.

Therefore, the above-discussed cited portions of *Spilo* do not disclose, teach, or suggest "backing up entire attributes of a file if it is determined that the file is resident" and "backing up attributes and data blocks belonging to the file if it is determined that the file is non resident," as recited in Claim 34.

B. **The Examiner's additional arguments presented in the current *Office Action* are also flawed**

1.   The cited portion of *Spilo* do not disclose, teach, or suggest "examining the attributes of each file and determining whether a file is resident or non resident," as recited in Claim 34.

As allegedly disclosing "examining the attributes of each file and determining whether a file is resident or non resident," as recited in Claim 34, the Examiner additionally cites column 8, lines 3-18 of *Spilo*. *Office Action* at 19. The cited portion of *Spilo* discloses that "file identification and file sequence numbers can be implemented . . . . Every file is assigned a unique identification number, based on its location within the directory structure . . . ." *Spilo* at 8:3-6. *Spilo* further discloses that "this is only one of numerous possible methods for allocating file identification numbers; other possibilities include . . . . a sequential number unrelated to a file's position within the directory structure." *Id.* at 8:8-15. The Examiner apparently equates a file having a file identification number related to its position within the directory structure (allegedly disclosed in *Spilo*) to a file that is "resident" (as recited in Claim 34) and a file having a file identification number not related to its position within the directory structure (allegedly disclosed in *Spilo*) to a file that is "non-resident" (as recited in Claim 34).

The cited portion of *Spilo* appears to disclose alternative configurations: one configuration in which "[e]very file is assigned a unique identification number, based on its location within the directory structure" and an alternative configuration in which every file is assigned a unique sequential identification number "unrelated to a file's position within the directory structure." In other words, *Spilo* does not appear to disclose a configuration including both file types (i.e., a file having a file identification number related to its position within the directory structure and a file having a file identification number unrelated to its position within the directory structure). Thus, *Spilo* still fails to disclose any "determination" among the file types, as recited in Claim 34. Furthermore, even assuming that *Spilo* did disclose an embodiment including both file types, the Examiner has still not cited any portion of *Spilo* disclosing "determining whether a file [has a file identification number related to its position within the directory structure] or [has a file identification number related to its position within the directory structure]," which would be required for the cited portions of *Spilo* to even possibly disclose the limitations recited in Claim 34.

Additionally, as allegedly disclosing "examining the attributes of each file and determining whether a file is resident or non resident," the Examiner cites column 10, lines 42-56 of *Spilo*. *Office Action* at 18-19. The cited portion of *Spilo* discloses that "[t]he supervisory program can be enabled to distinguish between critical data (e.g., system files and documents) and non-critical data (e.g., temporary files and other easily recreatable files) so that only critical files are backed up." *Spilo* at 10:47-50. The Examiner appears to be equating the "critical data" disclosed in *Spilo* with the "resident" file recited in Claim 34 and the "non-critical data" disclosed in *Spilo* with the "non-resident" file recited in Claim 34 such that "distinguish[ing] between critical data . . . and non-critical data" (as disclosed in *Spilo*) constitutes "determining whether a file is resident or non resident" (as recited in Claim 34). Even if these apparent equations are proper (which Applicant does not concede), *Spilo* would still fail to disclose, teach, or suggest "backing up entire attributes of a file *if it is determined that the file is resident*" and "backing up attributes and data blocks belonging to the file *if it is determined that the file is non resident*," as recited in Claim 34.

It is apparent that the Examiner is citing disjointed portions of *Spilo* in an attempt to map the teachings of *Spilo* to the limitations of Claim 34. Applicant respectfully reminds the Examiner that, in *Net Moneyin*, the Federal Circuit held that a finding of anticipation under 35 U.S.C. § 102 is proper only when a "reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way* as recited in the claim." *Net Moneyin* at *10 (emphasis added). The prior art reference must "*clearly and unequivocally* disclose the claimed invention . . . *without any need for picking, choosing, and combining various disclosures not directly related to each other by* the teachings of the cited reference." *Id.* (emphasis added, internal typographical notations omitted).

2.   The cited portions of *Spilo* do not disclose, teach, or suggest "backing up entire attributes of a file *if it is determined that the file is resident*" and "backing up attributes and data blocks belonging to the file *if it is determined that the file is non resident*," as recited in Claim 34.

As allegedly disclosing "backing up entire attributes of a file *if it is determined that the file is resident*," the Examiner cites column 10, lines 42-56 of *Spilo*, stating that

"[b]acking up entire attributes equates to only the critical files are backed up." *Office Action* at 19. The Examiner also cites column 10, lines 66 through column 11, line 11 of *Spilo*, stating that "[b]acking up entire attributes also equates to the file identification number should be stored within the files directory entry." *Office Action* at 19. The Examiner then cites column 8, lines 3-18 as allegedly disclosing "backing up attributes and data blocks belonging to the file *if it is determined that the file is non resident*," stating that "[b]acking up attributes and data blocks equates to the file identification number should be stored within the file's directory entry." *Office Action* at 19-20.

Applicant's again remind the Examiner that Claim 34 recites that a determination is made "whether a file is resident or non resident" and, based on that determination, either entire attributes of a file are backed up "*if it is determined that the file is resident*" or "attributes and data blocks" of a file are backed up "*if it is determined that the file is non resident.*" It is unclear to Applicant which of the above-discussed portions of *Spilo* the Examiner is now relying on as disclosing the determination (i.e., "determining whether a file is resident or non resident," as recited in Claim 34) resulting in either "backing up entire attributes of a file" or "backing up attributes and data blocks belonging to the file," as recited in Claim 34.

To the extent that the Examiner is relying on the portion of *Spilo* disclosing that "file identification and file sequence numbers can be implemented" as disclosing the determination recited in Claim 34 (discussed above), Applicant reiterates the above-discussed position that the cited portion of *Spilo* does not appear to disclose an embodiment including both a file having a file identification number related to its position within the directory structure and a file having a file identification number related to its position within the directory structure (as apparently asserted by the Examiner). Thus, the cited portion of *Spilo* fails to disclose any "determination" among the file types, let alone "determining whether a file is resident or non resident," as recited in Claim 34. Because the cited portion of *Spilo* does not disclose any determination, *Spilo* necessarily fails to disclose any action based on the determination, let alone "backing up entire attributes of a file *if it is determined that the file is resident*" and "backing up attributes and data blocks belonging to the file *if it is*

determined that the file is non resident," as recited in Claim 34.

To the extent that the Examiner is relying on the portion of *Spilo* disclosing that "[t]he supervisory program can be enabled to distinguish between critical data . . . and non-critical data" as disclosing the determination recited in Claim 34 (discussed above), Applicant submits that, even assuming that this portion of *Spilo* did disclose "determining whether a file is resident or non resident" (which Applicant does not concede), the cited portion of *Spilo* would still fail to disclose, teach, or suggest "backing up entire attributes of a file *if it is determined that the file is resident*" and "backing up attributes and data blocks belonging to the file *if it is determined that the file is non resident,*" as recited in Claim 34.

For example, it is unclear how "[t]he supervisory program . . . distinguish[ing] between critical data . . . and non-critical data" (*Spilo* at portion 10:42-56, cited by the Examiner as allegedly disclosing "determining whether a file is resident or non resident") impacts "the file identification numbers [being] stored within the file's directory entry" (*Spilo* at 8:15-18, cited by the Examiner as allegedly disclosing "backing up attributes and data blocks *if it is determined that the file is non resident*"). In other words, *how does distinguishing between critical data and non-critical data affect the storing of identification numbers in a file's directory entry?* Applicant's claim recites that a determination is made "whether a file is resident or non resident" and, based on that determination, "attributes and data blocks" of a file are backed up "*if it is determined that the file is non resident.*" It does not appear that the cited portion of *Spilo* discloses, teaches, or suggests these limitations.

C.   Conclusion

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 34.

III.   The Separately-Rejected Dependant Claims are Allowable

The Examiner rejects Claims 6-7, 18-19, and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Tamura-West* combination.   Claims 6-7 depend from independent Claim 1, Claims 18-19 depend from independent Claim 13, and Claims 27-28

depend from independent Claim 25. Neither *Tamura* nor *West* appear to disclose the limitations recited in independent Claims 1, 13, and 25, and the Examiner does not make any assertions to the contrary[1]. Thus, dependent Claims 6-7, 18-19, and 27-28 are allowable over the proposed *Tamura-West* combination at least because they depend on allowable independent claims.

To the extent the Examiner intended to reject Claims 6-7, 18-19, and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over *Dunham* in view of *Tamura* and/or *West*, Applicant reiterates that Claims 6-7, 18-19, and 27-28 depend from independent Claims 1, 13, and 25, respectively, which Applicant has shown above to be allowable over *Dunham*. *Tamura* and *West* do not make up for the above-discussed deficiencies of *Dunham*. Accordingly, dependent Claims 6-7, 18-19, and 27-28 are allowable over the cited references at least because they depend on allowable independent claims. Additionally, dependent Claims 6-7, 18-19, and 27-28 recite further patentable distinctions over the cited references. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 13, and 25, Applicant does not discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicant does not admit that the proposed combination of references is possible or that the Examiner has provided an adequate reason for combining or modifying the references in the manner proposed by the Examiner.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 6-7, 18-19, and 27-28.

The Examiner rejects Claims 8-9, 20-21, and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Tamura-West-Gold* combination. Claims 8-9 depend from independent Claim 1, Claims 20-21 depend from independent Claim 13, and Claims 29-30 depend from independent Claim 25. *Tamura*, *West*, and *Gold* do not appear to disclose the limitations recited in independent Claims 1, 13, and 25, and the Examiner does not make any

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[1] The Examiner actually cites *Dunham* as allegedly disclosing the limitations recited in independent Claims 1, 13, and 25, as discussed in Section I above.

assertions to the contrary[2]. Thus, dependent Claims 8-9, 20-21, and 29-30 are allowable over the proposed *Tamura-West-Gold* combination at least because they depend on allowable independent claims.

To the extent the Examiner intended to reject Claims 8-9, 20-21, and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over *Dunham* in view of *Tamura*, *West*, and/or *Gold*, Applicant reiterates that Claims 8-9, 20-21, and 29-30 depend from independent Claims 1, 13, and 25, respectively, which Applicant has shown above to be allowable over *Dunham*. *Tamura*, *West*, and *Gold* do not make up for the above-discussed deficiencies of *Dunham*. Accordingly, dependent Claims 8-9, 20-21, and 29-30 are allowable over the cited references at least because they depend on allowable independent claims. Additionally, dependent Claims 8-9, 20-21, and 29-30 recite further patentable distinctions over the cited references. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 13, and 25, Applicant does not discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicant does not admit that the proposed combination of references is possible or that the Examiner has provided an adequate reason for combining or modifying the references in the manner proposed by the Examiner.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 8-9, 20-21, and 29-30.

The Examiner rejects Claims 10-12, 22-24, and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over the proposed *Tamura-West-Blam* combination. Claims 8-9 depend from independent Claim 1, Claims 20-21 depend from independent Claim 13, and Claims 29-30 depend from independent Claim 25. *Tamura*, *West*, and *Blam* do not appear to disclose the limitations recited in independent Claims 1, 13, and 25, and the Examiner does not make any assertions to the contrary[3]. Thus, dependent Claims 10-12, 22-24, and 31-33 are

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[2] The Examiner actually cites *Dunham* as allegedly disclosing the limitations recited in independent Claims 1, 13, and 25, as discussed in Section I above.
[3] The Examiner actually cites *Dunham* as allegedly disclosing the limitations recited in independent Claims 1, 13, and 25, as discussed in Section I above.

allowable over the proposed *Tamura-West-Blam* combination at least because they depend on allowable independent claims.

To the extent the Examiner intended to reject Claims 10-12, 22-24, and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *Dunham* in view of *Tamura*, *West*, and/or *Blam*, Applicant reiterates that Claims 10-12, 22-24, and 31-33 depend from independent Claims 1, 13, and 25, respectively, which Applicant has shown above to be allowable over *Dunham*. *Tamura*, *West*, and *Blam* do make up for the above-discussed deficiencies of *Dunham*. Accordingly, dependent Claims 10-12, 22-24, and 31-33 are allowable over the cited references at least because they depend on allowable independent claims. Additionally, dependent Claims 10-12, 22-24, and 31-33 recite further patentable distinctions over the cited references. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 13, and 25, Applicant does not discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicant does not admit that the proposed combination of references is possible or that the Examiner has provided an adequate reason for combining or modifying the references in the manner proposed by the Examiner.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 10-12, 22-24, and 31-33.

IV.   No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.
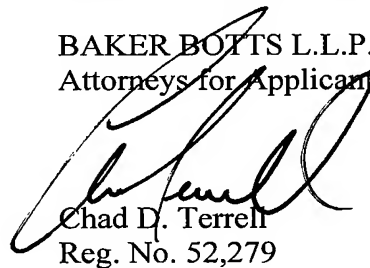
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Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

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Reg. No. 52,279

Date: April 2, 2009

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